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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/679,906	10/05/2000	Chan Daigle	25791.37.02	8824

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EXAMINER

NICHOLSON, ERIC K

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/679,906

Applicant(s)

DAIGLE ET AL.

Examiner

Eric K Nicholson

Art Unit

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 28-30, 37, 40-43 and 45-67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 37, 40-43 and 47-67 is/are allowed.
- 6) ☒ Claim(s) 1-7, 28-30, 45 and 46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Detailed Action

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-7,28,29 and 30 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-10 of copending Application

No. 10/331718. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: Expandable tubular members having a pair of threaded portions coupled to one another and a quantity of sealant within the threaded portions of the tubular members. Although the conflicting first claims of each application are not identical, they are not patentably distinct from each other because the sealant of 10/331718 of 10/3317718 also possesses the characteristic of adhering to the threaded portions as made known by the specification. Dependent claims 2-7,28,29 and 30 of the present invention are identical to claims 2-10 of application 10/3317718.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,5,28-30,45 and 46 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. patent 6,409,175 to Evans. The Evans patent discloses in column 1, lines 50-55 that is known to provide a pair of radially expanded tubular members having radially expanded threaded portions coupled to one another with a quantity of a sealant from a compound to effect a seal within the radially expanded threaded portions of the radially expanded tubular members wherein the sealant adheres to the radially expanded threaded portions of the radially expanded tubular members.

Claim Rejections – 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to

which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2,3,4,6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 6,409,175 to Evans et al. in view of the Jet-Lok product catalog and applicant's disclosure of Jet-Lok on page 7 of the specification. The Evans disclosure in column 1, lines 50-55 as noted above disclosed the claimed invention however the features of the sealant compound are not specified. The Jet Lok product catalog discloses that it is known in the art to use Jet-Lok sealant on threaded pressure fittings (page 3). Thread sealants are commonly used in the art to aid in locking and sealing threaded connections in order to give resistance to coming unthreaded due to vibration, high temperature and pressures. It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the sealant compound disclosed in Evans et al. in column 1, lines 50-55 with the Jet-Lok sealant, which as noted in the specification includes all of the characteristics of claims 2,3,4,6 and 7. The sealant providing a more secure coupling for the threaded members due to its ability to resist vibrations, high temperatures and pressure.

Claims 37,40-43 and 47-67 are allowed.

Applicant's arguments filed February 19, 2004 have been fully considered but they are not persuasive. Applicant argues that applicant's original application can not be prior art as a matter of law. The examiner agrees however the disclosure of the use of a sealing compound such as Jet-Lok III High Fiction Thread Compound which is readily available from Jet-Lube, Inc. is not considered to be using applicant's disclosure of his invention since applicant did not invent the Jet-Lok III High Fiction Thread Compound. Applicant argues that the divisional application 10/331718 cannot be used against the present application according to 35 USC section 121. The examiner agrees that the subject matter that was restricted can not be used as a reference against the present application however the subject matter of claims 1-10, while filed in the divisional application, is not the subject matter that was restricted out in the present application.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Nicholson whose telephone number is

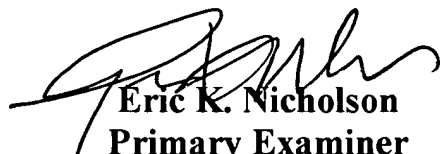
(703) 308-0829. The examiner can normally be reached on Tuesdays thru Fridays from 7:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola, can be reached on (703) 308-2686. The fax phone number for Technology Center 3600 is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center receptionist whose telephone number is (703) 308-1113.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

ekn
6/3/04


Eric K. Nicholson
Primary Examiner
Technology Center 3600